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REMARKS

Reconsideration and allowance of all the claims of record are respectfully requested. In response to the May 27, 2003 Advisory Action, the previously filed May 15, 2003 Amendment After Final is in substance being resubmitted herein in light of applicants' June 2, 2003 telephone conference with Examiner Boccio during which it was confirmed that the amendment format is consistent with PTO revised Amendment format practice.

Dependent claims 7, 9, 12, 17, 20 and 31 have been cancelled since the features of these claims have been substantially incorporated into their respective independent claims. Accordingly, no new issues have been raised by the addition of these features to their respective independent claims.

The applicants sincerely appreciate the courtesies extended by Examiner Boccio during the May 14 and 15, 2003 telephone interviews regarding the above-identified application. A summary of the arguments presented during the course of the interviews is set forth below.

In order to expedite the prosecution of this case, the applicants have amended the claims of record to, *inter alia*, emphasize that the claimed portable data transfer and repository device is an independent intermediary device which receives one or more flash memory modules for storage in a hard disk drive for later data transfer to a separate user computer device such as a user's notebook/laptop or desk top computer.

The claimed invention fulfills an important need not addressed by the applied prior art. The features defined by the claims of record allows, for example, a photographer to

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recover from unexpectedly filling up a camera memory module hiking in the wilderness and to conveniently reuse the memory module. Such a photographer will not likely be carrying a laptop under such circumstances, but may easily carry the device claimed herein.

Subsequently, after a series of photography excursions, the claimed invention can be used to transfer the captured images via the claimed "output port" to the user's laptop or desktop computer, in an environment where the bulkiness of the computer is no longer an issue. The claimed invention advantageously provides a convenient device for the conveyance of numerous images (perhaps many multiples of the number of images that will fit on one or more camera memory modules) between a camera and computer

The independent claims have been amended to eliminate the "palm sized" issue raised by the Examiner. "Palm sized" has now been replaced with closely related language which more closely follows language from the specification. Claims 1, 3, 11, 14, 16, 19, 22, 25, 26, 29 and 30 have been amended to even more clearly distinguish over the prior art applied by the Examiner. The applicants reserve the right to file a continuing application to seek coverage for the broader claims which the applicants likewise believe are patentable over the applied prior art.

Claims 1-31 stand rejected under 35 U.S.C. §103 as being unpatentable over Saito et al. in view of Yamauchi and Endsley et al.

For the reasons set forth below, the applicants submit that the collective teachings of Saito, Yamauchi and Endsley, fail to disclose or even remotely suggest the claimed invention as defined in each of the applicants independent claims 1, 11, 16, 22 and 25.

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The claims of record, particularly as presently amended, define a unique portable, palm-sized digital data transfer and repository apparatus and methodology which is not disclosed or suggested by the applied prior art.

The applicants submit that Saito lacks the features required by each of the claims of record in part because Saito does not disclose or suggest any kind of device which operates between a removable memory module and a user's laptop or desk top computer. Focussing, for example, on Figures 1 and 2 of Saito, the memory card 20 is inserted directly into the user's laptop computer 30. Particularly, as currently amended, the subject portable data repository claims do not correspond merely to a user's laptop computer. The claims of record require, *inter alia*, the particular structural elements which must be embodied in a device which exists independently of, and yet is designed to interface with, a user's computer and a removable flash memory module.

A significant objective of Saito is to provide a new camera design whose memory module may be more conveniently connected to a host computer than is accommodated by typical camera designs. The configuration of the camera is designed to match the form of a PC card (physically and electrically) to make plugging-into the host computer more convenient, and to allow remote operation of the camera from the host when it is plugged into the computer. Such a design suggests directly connecting the host computer compatible memory card - without the use of an intermediary data repository.

The applicants' device which can be held in the palm of hand can, for example, accept standard camera flash memory modules (SmartMedia, Compact Flash, Memory Stick, etc.) and copy the contents of these memory modules to a hard disk drive

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embedded in the device. If the images collected in the device are later transferred to a host computer (laptop or desktop PC), no part of the original camera(s) or memory module(s) used to collect the images are involved.

In contrast with the claimed invention, Saito does not describe an independent accessory, which can be used with any camera or any other device which stores data from standard memory modules. Rather, Saito defines a new form of a camera interaction with a PC, such as a laptop, through the laptop's PC card interface and, thus, describes an improved method for connecting the electronic still camera to the laptop.

The claim limitations which clarify that the data repository device can not be a laptop computer such as disclosed in Saito are significant. A laptop computer is too large, power-hungry and heavy for a photographer to easily carry anywhere while taking photographs.

The Yamauchi reference relied on by the Examiner fails to cure the above-identified deficiencies of the Saito reference. The filing unit 500 in Yamauchi does not include a "hard disk drive" as claimed. Further, it does not include an LCD display as claimed.

The image data editing machine such as shown in Yamauchi's Figure 62 includes (among other features) slots for memory modules. However, such an editing machine is intended for interactive use in viewing and managing image data, much in the manner a laptop can be used to perform the same functions. As such, it is not suitable in size, power requirements, and convenience to be used as portable image capture and transfer

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device which can be held in the palm of a hand and having the features claimed and would not have suggested such features.

Finally, the Endsley reference fails to cure the deficiencies in the Saito and Yamauchi references. The applicants are not claiming a USB interface in the identified independent claims and are not claiming this feature is isolation. Endsley's teaching of coupling a camera to a host computer USB port fails to disclose or suggest the features claimed of the portable repository device having the hard disk drive, LCD display and other features claimed, which can be held in the palm of a hand and is used to transfer data between a flash memory module and a user's computer.

Without using applicants claims as a guide to pick and choose elements of the three applied references, there is simply no way that the three applied references would be combined to result in the claimed invention. Even if the Examiner were of the view that it is conceivable that the applied references could be modified to result in the claimed invention, such a modification would not have been obvious within the meaning of 35 U.S.C. §103, unless the prior art suggests the desirability of such a modification. See In re Gordon, 773 F.2d 900 (Fed. Cir. 1984), and In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1 (Fed. Cir. 1983). Absent any such suggestion, the applicants can only conclude that any continued rejection based upon the applied references must necessarily be grounded upon an improper hindsight reconstruction.

In light of the lack of the above-identified specific teachings in the applied references, the Examiner has failed to present a *prima facie* case of unpatentability of the claimed invention. Unless such a case is presented, the applicants are entitled to the grant

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of a patent based upon the present application. See In re Oetiker, 24 U.S.P.Q. 2nd 1443 at 1444 (Fed. Cir. 1992).

In view of the foregoing, the applicants believe that all of the claims are in condition for allowance and action to that end is earnestly solicited. If any issues remain to be resolved, the Examiner is urged to contact applicants' attorney at the telephone number listed below.

Respectfully submitted,

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